

REMARKS/ARGUMENTS

Claims 1-25 are pending.

In the outstanding Office Action, Claims 1, 7, 8, 17 and 18 were rejected under 35 U.S.C. § 112, second paragraph; Claims 1-22 and 24-25 were rejected as being anticipated by DeBruine et al. (U.S. Patent Publication No. 2002/0138552); and Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over DeBruine.

In the reply, Applicants respectfully traverse each of the rejections in the outstanding Office Action.

With regard to the rejection under 35 U.S.C. § 112, second paragraph of Claim 1, the Office Action at paragraph 4 indicates that there is insufficient antecedent basis for the language “that is recognized on the second network”. It is unclear why the Office has rejected Claim 1 on this basis, as “second network” is introduced at line 4 of Claim 1 (“... connected with a second network ...”). Similarly, support for Claim 7 is found at line 3, support for Claim 8 is found at line 4, support for Claim 17 is found at lines 4-5, and support for Claim 15 is found at lines 5-6. Therefore, it is believed that the language objected to in paragraph 4 of the outstanding Office Action actually is compliant with 35 U.S.C. § 112, second paragraph. If the nature of the Office’s rejection is different than that which is addressed in the remarks above, the Examiner is invited to telephone the undersigned so that mutually agreeable claim language may be identified.

Regarding the anticipation rejection of Claim 1, for example, MPEP § 2131, and the prevailing case law require that “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). While the Office Action asserts that DeBruine discloses every element in Claim 1, Applicants explain below why DeBruine is not believed to show all the

features in the last element of Claim 1. In particular DeBruine does not teach that if a second information processing apparatus is determined not to be connected with the same network as that with which the first information processing apparatus is connected, communication with the second information processing apparatus is performed on the basis of a different address than the network-specific address, said different address being a global address that is recognized on the second network. The remarks provided in the amendment of June 27, 2008, are believed to be equally applicable herein, and therefore the remarks accompanying that entire amendment are incorporated herein by reference.

However, as a brief recapitulation, an advantage with the invention defined by Claim 1 is that it would enable a change from a private network address to an IP address based on whether the destination is within a same private network as the sending apparatus. In a non-limiting example, if the first apparatus and the second apparatus are connected on a same network, communication with the second information processing apparatus is performed on the basis of a network-specific address defined on the first network. Thus, communication between the two apparatuses may be performed using a local address that is only meaningful within the network in which both the first apparatus and the second apparatus are members. However, when the two apparatuses are on different networks, a different address than the network-specific address is used, where the different address is a global address that is recognized on the second network. One non-limiting example of the global address is a global IP address that even works on the Internet.

In paragraph 24 of the Office Action, the Office asserts that DeBruine teaches using network 10 (Internet) with private network 16 (LAN).¹ The Office also asserts that the background of the reference [DeBruine] explains that typical file transfers occur over the Internet, and to optimize cost and bandwidth it is determined if clients and server nodes are

¹ Office Action page 11, first paragraph.

on the same LAN.² The Office Action then appears to conclude that “if it is determined that the client and server are on the same LAN, files are transferred locally.”

In reply, assuming everything described at pages 10 and 11 of the Office Action is accurate, even this explanation is insufficient to identify where every element of Claim 1 is found in DeBruine. In particular, Claim 1 requires that if the second information processing apparatus is not connected with the same network as that in which the first information processing apparatus is connected, communication with the second information processing apparatus is performed on the basis of a different address than the network-specific address, said different address being a global address that is recognized on the second network. This feature is simply absent in DeBruine.

While DeBruine describes an ability to exchange files between computers either in a LAN (16 of Figure 1A) for example, or over the Internet for example (see computer 14 which is connected to the computer in the LAN 16 of Figure 1A), all communications are performed using the unique IP address assigned to the computer (see discussion at [0023], explaining that each PCP/IP packet uses a client IP address and a destination IP address). In particular, the IP addresses that are used, are conventional in that they are four sets of number that are separated by periods [0023]. Determining whether the two computers (client nodes) are locally reachable from a same private network, the process described in Figures 4A and 4B are used [0029]. As seen in step 170 (Figure 4B), even if a target node is directly reachable, the requesting node uses an IP address to make the connection. Thus, DeBruine uses the same address regardless if communicating over a LAN or the Internet. Because the IP address is usable over the Internet, as well as over a private network, the addressing process used in DeBruine does not comply with the claimed “a different address than the network-specific address, said different address being a global address that is recognized on the

² Office Action page 11, first paragraph.

second network”, Claim 1. Moreover, Claim 1 requires the use of a network-specific address when the first and second information processing apparatuses are determined to be used in a same network, and the use of different addresses than the network-specific address when the first and second apparatuses are not connected with the same network. This feature is absent in DeBruine. Therefore, because DeBruine does not teach or suggest all of the elements of Claim 1, it is respectfully submitted that the Office Action fails to comply with the requirements of MPEP 2131, namely that anticipation of a claim requires that the reference must teach every element of the claim. The same feature is found in Claims 2-18, and therefore it is believed that Claims 2-18 also patentably define over DeBruine.

Claim 19, includes means plus function elements, also requires that the first address is connected with the second network being an address translator for address translation, and expressly includes “informing means for informing the first apparatus of the result of the examination performed by the examination means”. Support for the informing means, is found at least in the present specification at Figure 11, communication using the local address-based communication when the two devices are connected on a same network, as opposed to Figure 13 and 14 which describe the use of the global address when the two devices are determined not to be connected on a common network. As such, the feature discussed above with regard to Claim 1 corresponds with the informing means as presently claimed in Claim 19. Thus, for the same reasons discussed above with regard to Claim 1 it is respectfully submitted that Claim 19 also patentably defines over DeBruine. Likewise, it is respectfully submitted that Claims 24 and 25 also patentably define over the asserted prior art for reasons discussed above with regard to Claim 19.

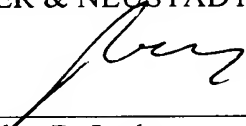
Claim 23 stands rejected as being obvious over DeBruine, where the Office asserts that DeBruine renders obvious the features described in Claim 23 regarding transmitting an examination result in a one-bit form. Assuming *arguendo* that is correct, this aspect of

DeBruine does not cure the deficiency discussed above with regard to Claim 19. As such, it is respectfully submitted that the Office has failed to meet its burden of providing a *prima facie* case of obviousness with regard to amended Claim 23, as DeBruine does not disclose all of the elements of Claim 23.

Consequently, in view of the foregoing comments it is respectfully submitted that the invention defined by Claims 1-25 is patentably distinguishing over the prior art. The present application is therefore believed to be in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully submitted,

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